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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/271,502	03/18/1999	TAKASHI HONDA	450100-4811	4228

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NEW YORK, NY 10151

EXAMINER

TRAN, THAI Q

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/271,502

Applicant(s)

HONDA, TAKASHI

Examiner

Thai Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14,37-43 and 54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14,37-43 and 54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed July 26, 2004 have been fully considered but they are not persuasive.

In re pages 10-11, applicant argues, with respect to claims 1, 13, 37, 42, and 54) that the device of Yamagami does not include an image pickup means (i.e., a computer) performs data transfer, whereas this present invention a recording/reproducing apparatus incorporating an image pickup means performs data transfer, the recording/reproducing apparatus of the present invention includes an image pickup means and is therefore not analogous to the computer of Yamagami and, therefore, Yamagami does not disclose a recording/reproducing apparatus that incorporates an image pickup means as instantly claimed.

In response, the examiner respectfully disagrees. First at all, it is noted that incorporate can be defined as "to unit (one thing) with something else already in existence" or "to cause to merge or combine together into a united whole". Yamagami discloses in page 3, paragraph #0039 that the communication path 116 for connecting the digital camera 100 according to this embodiment to the host computer 115 is constituted by a serial or parallel cable. The digital camera 100 and the host computer 115 of Yamagami are combined together into a united whole and; therefore, the host computer 115 incorporating the digital camera 100. Thus, the host computer 115 of Yamagami anticipated the claimed recording/reproducing apparatus.

Additionally, Yamagami discloses in page 3, paragraph #0048 that "As another embodiment, the following arrangement is provide. That is, a media recording I/F 117 for a read/write operation of a detachable recording media 118 is attached to the host computer 115, and a data file in which the attribute information and file name constituting information are stored is formed on the detachable recording media 118. When the camera receives a detachable recording media 108, and when there is a data file in which the pieces of set information are stored, attribute information may stored in an image file by using the set information, or the file name may be determined. In this manner, the attribute information and the file name can be changed for each detachable recording media, and more compatible recording of attribute information and formation of a file name can be performed". From the above passage, it is clear that the host computer 115 of Yamagami control data transfer between the detectable recording media.

In re page 15, applicant states that dependent claims 2-12, 14, 38-41, and 43 are patentable over the cited references on the basis of its dependence on claims 1, 13, 37, and 42.

In response, as discussed above with respect to claims 1, 13, 37, and 42 that Yamagami discloses all the claimed limitations of claims 1, 13, 37, and 42.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-5, 10, 13-14, 37-39, 42-43, and 54 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamagami (US 2002/0033888 A1) as set forth in the last Office Action.

Regarding claim 1, Yamagami discloses a recording/reproducing apparatus incorporating an image pickup means (101 of Fig. 1, page 2, paragraph nos. 0023 and 0024) for generating a picked-up-image signal, the recording/reproducing apparatus (Figs. 1-2) comprising:

first writing means (108 of Fig. 1, page 2, paragraph no. 0025) for writing the picked-up-image signal on a first removable recording medium;

reading means (108 of Fig. 1, page 2, paragraph no. 0026) for reading an image signal from said first recording medium;

second writing means (118 of Fig. 1, page 2, paragraph no. 0030 and page 3, paragraph 0048) for writing the image signal read by said reading means on a second removable recording medium while said first and second recording media are concurrently connected to the recording/reproducing apparatus incorporating said image pickup means; and

control means (115 of Fig. 1, page 2, paragraph no. 0030 and page 3, paragraph 0048) for controlling recording/reproducing and data transfer between said first and

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second recording mediums while connected to the recording/reproducing apparatus incorporating said image pickup means.

Regarding claim 2, Yamagami also discloses the claimed identification-information detecting means (the file name disclosed in page 2, paragraph no. 0028 and page 4, paragraph no. 0061); wherein said control means performs control in accordance with detected identification information (page 4, paragraph no. 0061).

Regarding claim 3, Yamagami discloses the claimed identification-information recording means (the file name disclosed in page 2, paragraph no. 0028) for recording identification information together with the picked-up-image signal on said first recording medium when the picked-up-image signal is recorded on said first recording medium as a still image; and

identification-information detecting means (page 4, paragraph no. 0061) for detecting identification information of the image signal read from said first recording medium, wherein

said control means controls said second writing means to write the image signal read by said reading means on said second recording medium only when identification information has been detected by said identification-information detecting means (page 4, paragraph #0061).

Regarding claim 4, Yamagami discloses the claimed wherein said control means performs control to cause said reading means to collectively read image signals and said second writing means to collectively write the image signals on said second

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recording medium (page 2, paragraph no. 0030; page 3, paragraph no. 0048; and page 4, paragraph #0062).

Regarding claim 5, Yamagami discloses the claimed wherein said second writing means is able to write the picked-up-image signal on said second recording medium (page 2, paragraph no. 0030; page 3, paragraph no. 0048; and page 4, paragraph #0062).

Regarding claim 10, Yamagami discloses the claimed wherein said control means is able to switch the mode between a first mode in which said reading means collectively reads image signals and said second writing means collectively writes the read image signals on said second recording medium and a second mode in which said reading means reads image signals one by one and said second writing means, one by one, writes the read image signals on said second recording medium (page 2, paragraph no. 0030; page 3, paragraph no. 0048; and page 4, paragraph #0062).

Claim 13 is rejected for the same reasons as discussed in claim 1 above and, additionally, Yamagami also discloses the claimed converting means (106 and 117 of Fig. 1, page 2, paragraph nos. 0026 and 0030) for subjecting the signal read by said reading means to a predetermined conversion process.

Regarding claim 14, Yamagami also disclosed the claimed wherein said converting means converts the image signal read by said first reading means to be adaptable to a Personal Computer Memory Card Internal Association Input/Output (PCMCIA I/O) or PCMCIA AT Attachment Interface (ATA I/F) to supply the converted

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image signal to said second writing means (page 3, paragraph nos. 0037, 0038, and 0039).

Method claims 37-39 are rejected for the same reasons as discussed in apparatus claims 1-2 and 10 above.

Method claims 42-43 are rejected for the same reasons as discussed in apparatus claims 13-14 above.

Regarding claim 54, Yamagami discloses a recording/reproducing apparatus incorporating an image pickup means (101 of Fig. 1, page 2, paragraph nos. 0023 and 0024) for generating a picked-up-image signal, the recording/reproducing apparatus (Figs. 1-2) comprising:

writing means (108 of Fig. 1, page 2, paragraph no. 0025) for writing the picked-up-image signal on a first removable recording medium;

reading means (108 of Fig. 1, page 2, paragraph no. 0026) for reading an image signal from said first recording medium;

removable writing means (118 of Fig. 1, page 2, paragraph no. 0030 and page 3, paragraph 0048) for writing the image signal read by said reading means on a second removable recording medium while said first and second recording media are concurrently connected to the recording/reproducing apparatus incorporating said image pickup means; and

control means (115 of Fig. 1, page 2, paragraph no. 0030 and page 3, paragraph 0048) for controlling recording/reproducing and data transfer between said first and

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second recording mediums while connected to the recording/reproducing apparatus incorporating said image pickup means.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamagami (US 2002/0033888 A1) as set forth in the last Office Action.

Regarding claim 7, Yamagami discloses all the claimed limitations as discussed in claim 1 above except for providing the claimed wherein said first recording medium is a tape-shape recording medium.

Yamagami teaches that the storage media such as a floppy disk, a hard disk, an optical disk, an photomagnetic disk, a CD-ROM, a magnetic tape, a nonvolatile memory card, a ROM, or the like can be used (page 2, paragraph no. 0026 and page 4, paragraph no. 0052).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the tape-shape recording medium as taught by Yamagami into Fig. 1 of Yamagami since it merely amounts to selecting an alternative equivalent recording medium.

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Regarding claim 8, Yamagami discloses all the claimed limitations as discussed in claim 1 above except for providing the claimed wherein said second recording medium is a disc.

Yamagami teaches that the storage media such as a floppy disk, a hard disk, an optical disk, an photomagnetic disk, a CD-ROM, a magnetic tape, a nonvolatile memory card, a ROM, or the like can be used (page 2, paragraph no. 0026 and page 4, paragraph no. 0052).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the disc as taught by Yamagami into Fig. 1 of Yamagami since it merely amounts to selecting an alternative equivalent recording medium.

Regarding claim 9, Yamagami discloses all the claimed limitations as discussed in claim 1 above except for providing the claimed wherein said second recording medium is a memory card.

Yamagami teaches that the storage media such as a floppy disk, a hard disk, an optical disk, an photomagnetic disk, a CD-ROM, a magnetic tape, a nonvolatile memory card, a ROM, or the like can be used (page 2, paragraph no. 0026 and page 4, paragraph no. 0052).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the memory card as taught by Yamagami into Fig. 1 of Yamagami since it merely amounts to selecting an alternative equivalent recording medium.

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6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamagami (US 2002/0033888 A1) in view of Spitzer et al (US 2001/0012067) as set forth in the last Office Action.

Yamagami discloses all the claimed limitations as discussed in claims 1 and 5 above and, additionally, Yamagami also discloses that the control means (the host computer 115) can select different modes of reading the images recorded on the first recording medium (page 2, paragraph no. 0030; page 3, paragraph no. 0048; and page 4, paragraph #0062). However, Yamagami does not specifically disclose the claimed wherein said recording/reproducing apparatus has an all-pixel reading mode (progressive mode) in which said image pickup means generated a picked-up image signal by reading all pixels and an interlace reading mode in which said image pickup means generates a picked-up-image signal by interlaced-reading.

Spitzer et al teaches a definition television camera, which minimizes the effect of dark current, reflective regions, contamination problems, improves the signal-to-noise ratio, and produce a variable frame rate without post-processing, can be operated in either progressive-scan mode or interlace-scan mode (the abstract) for generating a high resolution picture in a progressive format such that it is compatible with the proposed US HDTV standards for the progressive format, for transferring charge from the image region to the storage region during the brief blanking period while producing a high-resolution image (page 2, paragraph nos. 0014, 0015, 0016, 0017, 0018, 0019, and 0020).

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It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the camera as taught by Spitzer et al into Yamagami's system in order to increase the quality of the video signal by minimizes the effect of dark current, improves the signal-to-noise ratio, and etc..

7. Claims 11-12 and 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamagami (US 2002/0033888 A1) in view of Hong (US Patent No. 5,257,142) as set forth in the last Office Action.

Regarding claim 11, Yamagami discloses all the claimed limitations as discussed in claim 1 above, except for providing the claimed wherein said control means causes said second writing means to interrupt writing an image signal on said second recording medium when said second recording medium is filled to capacity and communicates that said second recording medium has been filled to capacity.

Hong teaches a video cassette recorder having the capability of interrupting the writing of video signal on the recording medium when the recording medium is filled to capacity and communicating that the recording medium has been filled to capacity (col. 4, lines 23-43) to prevent at least a video signal in the television program content from discontinuity or interruption occurring by cassette replacement (col. 1, lines 41-45).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the capability of interrupting the writing of video signal on the recording medium when the recording medium is filled to capacity as taught by Hong in order to prevent at least a video signal from discontinuity or interruption occurring by medium replacement.

Regarding claim 12, Hong also discloses the claimed wherein said control means causes said second writing means to restart writing when said second recording medium has been changed to a state in which writing on said second recording has been interrupted because said second recording medium has been filled to capacity and said changed second recording medium has an empty capacity (col. 4, line 23 to col. 5, line 7).

Method claims 40-41 are rejected for the same reasons as discussed in apparatus claims 11-12 above.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (571) 272-7382. The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

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The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTQ


THAI TRAN
PRIMARY EXAMINER